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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/752,345	01/06/2004	Luc Mainville	055189-0011	4226

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EXAMINER

HORTON, YVONNE MICHELE

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 07/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/752,345

Applicant(s)

MAINVILLE, LUC

Examiner

Yvonne M. Horton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) 3 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/06/06 has been entered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1,2,4 and 5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In the claims, seeing how the tubular sections are sealed off as at (42,46 ,50), it is not clear how ambient air is allowed to "freely" enter the tubular sections. In particular, there appears to be only one entry port (28) however element (28) is detailed as being designed for "fluid" entry. Ambient air is not a "fluid", but rather a gas. Thus, the claims do not detail how ambient air enters and is allowed to flow

freely within the hoist. Until further clarification, the claims have been addressed considering that the hoist has ambient air within that is allowed to flow "freely" therein.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In these claims, it is not clear how the tubular sections have a "semi-lubricated contact" therebetween. Does the nitrided steel provide for the "semi-lubricated contact" or does the fluid provide for the "semi-lubricated contact". Clarification is required. For purposes of this Action, the claims have been addressed with both the nitrided steel and fluid providing for "semi-lubricated contact".

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,2,4 and 5 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #5,983,778 to DAWSON in view of US patent #3,508,773 to COBERLY et al. Regarding claims 1,2,4 and 5, DAWSON discloses the use of a telescopic hoist including a cylindrical housing (12) series of tubular sections (14-20) each having first and second ends such that the first end includes an annular head (64-72) having with openings (94-102), a piston end (26) also with an opening or inlet/outlet port (28) that allows for the introduction of fluid into successive areas (12a,14a,16a,18a,20a) and

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contains the fluid between the piston head (26) and another piston head (88), column 3, lines 49-53, and sealing means (74-82) sealing the fluid between the tubular sections (3,6) such that air from between the sections (12-20) is free to enter the heads (64-72) at the openings (94-102) formed therein such that the fluid and grease provides for a "semi-lubricated contact" between the members (14-20). DAWSON discloses the basic claimed device except for forming the device out of nitrided steel. COBERLY et al. teaches that it is known in the art to form telescopic members (32,34,22) out of nitrided steel, column 9, lines 5-10. Hence, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the telescopic hoist members of DAWSON out of nitrided steel, as taught by COLBERLY et al., in order to not only form a hoist that high strength potential and surface hardness, but that also is durable. Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select a known material on the basis of its suitability for the use intended as an obvious matter of design choice. For instance perhaps a steel structure is suitable in environment for use where extremely heavy devices are hoisted. Nitrided steel has a very effective coefficient of friction and will wear less as a result of any potential rubbing between the members of the hoist sections. In further reference to claim 5, the tubular sections (14-20) includes at least an outermost (14) and an innermost section (20) that allow fluid to be introduced into section (14a-18a) located between at least the outermost (14) and innermost (20) sections.

***Response to Arguments***

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Applicant's arguments filed 06/06/06 have been fully considered but they are not persuasive in part.

Regarding the applicant's argument that the device of DAWSON does not allow freely into or out thereof, DAWSON, column 3, lines 30-48, clearly details that air is excavated through ports (94,96,98,100,102) and is also allowed to be drawn into spaces (12a,14a,16a,18a,20a). Having air drawn into the sections without detailing any inhibitors, the air of DAWSON is freely drawn and is exited freely as a result of the introduction of fluid within the members (12,14,16,18,20).

The remainder of applicant's arguments with respect to claims have been considered but are moot, in part, in view of the new ground(s) of rejection.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne M. Horton whose telephone number is (571) 272-6845. The examiner can normally be reached on 6:30 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on (571) 272-6842. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yvonne M. Horton  
Art Unit 3635  
06/25/06